

In re Application of OJANEN
Serial No. 09/838,348

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Group Art Unit 3673

Response to the Non-Final Office Action of February 1, 2005

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Remarks

Introduction

Applicant notes that the Patent Examiner maintains the rejection under 35 USC §112, 1st ¶ and now rejects the claims under 35 USC §102(e) based upon U.S. Patent No. 6,397,652 to Sollami. Applicant respectfully disagrees with the Patent Examiner's positions on each one of the above issues for the reasons stated below. Applicant submits that the arguments presented herein clearly establish compliance with 35 USC §112, 1st ¶ and patentability over the '652 Sollami patent. Applicant solicits the removal of the rejections and the issuance of a Notice of Allowability and Notice of Issue Fee Due.

The Rejection of Paragraph 2 – 35 USC §112, 1st Paragraph

The pertinent statutory basis (35 USC §112 1st ¶) for this rejection reads:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, ...

Under United States patent jurisprudence, the Federal Circuit held in In re Swartz, 56 USPQ 2d 1703 (Fed. Cir. 2000):

To satisfy the enablement requirement of §112, ¶ 1, a patent application must adequately disclose the claimed invention so as to enable a person skilled in the art to practice the invention at the time the application was filed without undue experimentation.

The predictability of the pertinent art impacts the assessment of undue experimentation. Enablement is more easily satisfied in predictable arts like the mechanical arts. Here, this invention pertains to the predictable mechanical arts.

As best understood, the essence of this enablement rejection is that the statement at page 11, lines 14-17 renders the patent application non-enabling because the "claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention."

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It is imperative to keep in mind that to properly construe the text-in-question (page 11, lines 14-17), one has to read this sentence in its context and through the eyes of a person skilled in the pertinent art. In this regard, the "same drawback as the prior art" referred to in the above-quoted text at page 11, lines 14-17 is the drawback referred to in the earlier paragraph that concerns the difficulty in removal experienced by some prior art tools due to the accumulation of dirt and debris. This paragraph, which reads at page 10, line 34 through page 11, line 13, and the text-in-question read as follows:

U.S. Patent No. 4,484,783 to Emmerich, and 3,519,309 to Engle et al. disclose retainers having radially protruding surfaces (dimples, bulge) that cooperate with a notch of the bit holder bore. These protruding surfaces of the retainer are spring loaded so as to expand into the bore notch whenever the cutting tool/retainer assembly is inserted into the bore. These type prior art designs often became difficult to remove from bit holders after continued usage on cutting equipment. When these type prior art designs are used on mining and construction equipment, dirt and cutting debris would penetrate the clearances between the shank, retainer and bit holder bore and accumulate in the shanks annular groove. **This debris and dirt interferes with the inward radial play of the radially protruding surfaces, making the tools very difficult and sometimes impossible to remove.**

The invention includes protruding dimples that are designed to require no radial play and, therefore, do not suffer from the same drawback as the prior art.

The only reasonable reading of the above-quoted text is that the "same drawback as the prior art" has to do with the difficulty in the removal of the tool when dirt has accumulated between the retainer and the tool body.

To appreciate this condition, an enlarged copy of FIG 8 of Engle et al. (Exhibit A that was attached to the Response to the Office action of July 26, 2004) and FIG. 6 of Emmerich (Exhibit A-1 that was attached to the Response to the Office Action of July 26, 2004) were modified to show the accumulation and compaction of dirt and debris between the retainer and tool shank. When in this condition, it seems apparent that the dimple must

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exhibit inward radial play or else require an excessive amount of force to shear these dimples and thus remove the tool from the bore of the holder.

In contrast, an enlarged view of FIG. 12 of the present application (Exhibit B that was attached to the Response to the Office action of July 26, 2004) was modified to show the condition when dirt and debris are between the retainer and the tool body. When in this condition it is apparent that less radial inward play (or movement) of the dimple (46) is necessary to remove the tool using the retainer of FIG. 12 than with the tools shown in Engle et al. or Emmerich.

The statement at page 11, lines 14-17 refers to the design of the dimples wherein they "require no radial play" for the removal of the tool. *The plain and simple meaning of this language is not that there may not be any radial play of the dimples upon removal of tool, but only that radial play is not a requirement for removal of the tool*¹. Inward radial play of the dimples is not a requirement to remove the tool because the dimples only project between about 15 percent and about 30 percent of the thickness dimension of the retainer. This is, of course, in significant contrast to prior art dimples like those taught in Engle et al. and Emmerich (patents that were used in an earlier Office Action), as well as the '652 Sollami patent used in the instant Office Action, that due to their more extended projection, must experience some inward radial play in order to remove the tool without the exertion of excessive force.

There is no ambiguity about the language under discussion. The specification does, in fact, enable the claims. Applicant solicits the removal of this rejection.

¹ The patent examiner should consider the language at page 12, lines 15-21 of the present patent application that reads:

The flared mouth section 32 of the bore 20 provides from a smooth reception of the dimples about the circumference of the retainer of the cutting tool during installation of the cutting tool into the bit holder. The cooperation of the dimples with a notch improves the strength of the connection between the retainer and bit holder.

In view of the fact that the flared mouth section would compress the retainer upon insertion of the tool into the bore, and the mention of the cooperation of the dimples with the notch (which implies a radial outward movement), it is clear that the specification teaches a retainer that has radial movement.

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The Rejection of Paragraph 4 – 35 USC §102(e)

The Patent Examiner has rejected claims 15-17, 29-30, 32-40 and 43-47 under 35 USC §102(e) as being anticipated by the '652 Sollami patent. Applicant hereby respectfully requests the removal of this rejection for the reasons set forth below.

Applicant first points out that the dimension of the dimples or the protruding surface as called out in the claims makes a difference. The reasons supporting this have been set out in the Response to the Non-Final Office Action of July 26, 2004.

In addressing the numerical range as set forth in the claims, the Patent Examiner used the '652 Sollami Patent and wrote, "... the amount of radial projection of said protruding surface beyond the cylindrical surface of the retainer is between about 15 percent and about 30 percent of the thickness dimension of said retainer (see Fig. 15)." Please see page 4, lines 3-5 of the Office Action of February 1, 2005. Attached hereto as Exhibit H is an enlarged copy of the tool illustrated in Fig. 15 of the '652 Sollami Patent. Measurement of the thickness of the retainer ("THICKNESS" in Exhibit H) in comparison to the distance of the radial projection ("RADIAL PROJECTION" in Exhibit H) establishes that the radial projection is about 88.9 percent (RADIAL PROJECTION/ THICKNESS) of the thickness of the retainer. In light of this measurement, applicant submits that the '652 Sollami patent cannot anticipate the claims under 35 USC §102(e).

Conclusion

Applicant respectfully submits that the pending claims define over the applied documents. Applicant solicits the issuance of a Notice of Allowability and a Notice of Allowance and Issue Fees Due. Applicant requests if the patent examiner does not agree with the applicant's arguments, but has suggestions to place the claims in form for allowance, that

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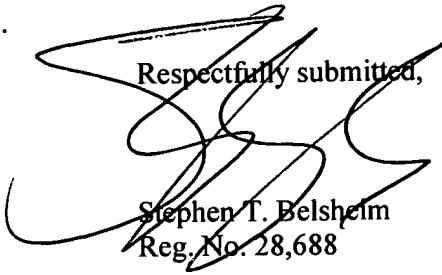
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the patent examiner telephone the undersigned attorney (615 662 0100) or Mr. Matthew W. Smith (724-539-3848) to discuss the case.

Respectfully submitted,


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